

REMARKS

Applicants have carefully reviewed and considered the Examiner's Office Action dated December 21, 2005. This Amendment accompanies a Request for Continued Examination (RCE) and reconsideration of the rejections is respectfully requested in view of the foregoing amendment and comments set forth below.

By this Amendment, independent claim 8 is amended; claims 2-6 are amended to depend directly or indirectly from independent claim 8; claims 1 and 16-18 are canceled; and new claims 19-21 are added. Accordingly, claims 2-15 and 19-21 are pending in the present application, with claims 7 and 10-15 withdrawn from consideration as they are directed to a non-elected species.

The Office Action rejected claims 1-2, 8, and 16-18 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 4,020,751 to Greve et al. (hereinafter referred to as "Greve") for the reasons set forth in paragraph 2 of the Action. This rejection is respectfully traversed.

It is the Action's position Greve's disclosure of applying two types of paste (from two different sources) meets the claimed method steps of: 1) positioning an applicator having orifices of at least two nozzles; 2) establishing at least two sources of flowable adhesive to the orifices of the single applicator; and 3) conveying flowable adhesive from each of the sources along a discrete path to a different one of the orifices of the single applicator. However, in the Response to the Arguments section of the Action, the Examiner indicates that the "pasters" of Greve are "applicators". That is, the Examiner recognized that Greve does not disclose a method with a single applicator having a orifices of at least two nozzles. Instead, as acknowledged by the Examiner, Greve

discloses two separate applicators (one paster with nozzles 34, 36 that receive adhesive from container 33 and a second paster 32 which receives adhesive from container 38) and not a method employing a single applicator that receives adhesive from more than one source, as recited in independent claim 8. Accordingly, Greve cannot anticipate the claims because it fails to disclose the recited positioning, establishing and conveying steps.

In order to further distinguish the claimed invention of making rod-shaped smokers' products, the steps of "subdividing the web that has been coated with adhesive into uniting bands" and "attaching a uniting band to one end portion of a plain cigarette and to one end of a filter mouthpiece to join the cigarette and the filter mouthpiece" have been added. Support for these steps can be found on page 11, lines 9-11 and page 22, lines 2-8 of the originally filed specification.

Greve is directed to making composite filter plugs and discloses applying adhesive to convert a web of wrapping material into the tubular wrapper of a composite filter rod. There is no disclosure in Greve of subdividing the web to make uniting bands; instead Greve discloses that adhesive is applied to the web that is converted into a tubular wrapper without being subdivided. Accordingly, Greve cannot anticipate the two steps added to independent claim 8. Consequently, Greve fails to disclose at least the method of using one applicator to apply two different adhesives and the subdividing of the web to form a uniting band. Withdrawal of the rejection to claims 2 and 8 is respectfully requested.

Claims 1-6, 8-9 and 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Greve as explained in paragraph 4 spanning pages 2-3 of the Action.

This rejection is respectfully traversed.

As argued above, Greve only discloses a method for applying one type of adhesive via a first applicator and another type of adhesive via a second applicator. There is no suggestion that these two different types of applicators can be combined into a single applicator as recited by Applicants. Thus, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to modify Greve so that a single applicator applies adhesive from two different sources, let alone from two discrete first and second source (as recited in claim 2).

With respect to dependent claims 3-5, the Action admits that Greve does not disclose that the “paste” is “intermittently applied” to one side of the web and that the recited rotary valve, and pump are not taught by Greve. However, the Action baldly concludes that the intermittent application, rotary valve and pump would have been obvious to one of ordinary skill in the art. To the contrary, one of skill in the art reading Greve would not have been motivated to modify the applicators of Greve to apply adhesive intermittently because the goal of Greve was to prevent undesirable shifting of sections with respect to one another (column 2, lines 2-3 of Greve). Thus, Greve teaches one of ordinary skill in the art to ensure that there are strips of adhesive applied to the web. There is no reason why one of ordinary skill in the art would skip sections of the web in view of Greve’s teachings. In the absence of a reference teaching the recited features of dependent claims 3-5, there is no motivation to modify Greve. If the Examiner continues this rejection, she is asked to provide a reference supporting the statement that the features of claims 3-5 “are not deemed to patentably distinguish the claims from the reference”.

Similarly, the Examiner rejects claims 6 and 9 without any reference that teaches the features in the dependent claims. Instead, the Examiner appears to be relying upon a hindsight evaluation of the features of the claims based on the information provided by Applicants. This type of rejection is not permissible under the U.S. patent laws and does not provide the necessary motivation to modify Greve.

The present invention offers several advantages over the method taught by Greve. First, a single applicator is employed through which different sources of adhesive are applied to selected portions of the web. As acknowledged by the Examiner, Greve teaches two different applicators that are separated by a distance. The method of the claimed invention has several objects, as recited on pages 7-8 of the originally filed specification. The recited method of making rod-shaped smoker's products including a filter and a cigarette greatly reduces the likelihood of injury and/or startling of the smoker due to the filter becoming separated from the cigarette portion as a result of the uniting band and method of applying the same. In addition, the method of the claimed invention allows one to economize on adhesive regardless of the pattern formed by the adhesive. This is not taught by Greve; nor are the recited method steps taught or suggested by Greve. Consequently, Greve does not render the claimed invention obvious or unpatentable because it does not disclose, teach or suggest the recited features of the claim as argued above. Withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

In view of the foregoing, it is respectfully submitted that independent claim 8 and dependent claims 2-6, 9, and 19-21 are allowable over the prior art of record.

Reconsideration of the application and an issuance of a Notice of Allowance are earnestly solicited.

If the Examiner is of the opinion that the prosecution of the application would be advanced by a personal interview, the Examiner is invited to telephone undersigned counsel to arrange for such an interview.

Respectfully submitted,

Date: March 21, 2006



Catherine M. Voorhees
Registration No. 33,074
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Telefax : (202) 344-8300

CMV/elw

::ODMA\PCDOCS\DC2DOCS1\733884\1